

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Greg B. Hale	Examiner:	Scott E. Beliveau
Serial No.	10/692,513	Group Art Unit:	2623
Filed:	October 24, 2003	Docket No.	54317-022501
Title:	<i>STREAMING OF DIGITAL DATA TO A PORTABLE DEVICE</i>		
Customer No.:	46560		

CERTIFICATE OF TRANSMISSION

I hereby certify that this document is being transmitted electronically to the United States Patent and Trademark Office via the EFS Web e-Filing system on March 21, 2007.

Name: 
Sherry B. Kolber

**LETTER SUBMITTING REMARKS WITH
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP: AF
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir/Madam:

This paper is being filed with a Request For Pre-Appeal Brief Review and a Notice of Appeal.

REMARKS

Applicant seeks formal review by a panel of Examiners of the rejections set forth in the Final Office Action dated October 27, 2006 in view of Applicant's declaration and response filed on September 11, 2006. The claims have been rejected twice. Accordingly, Applicant's appeal of the rejections and request for pre-appeal brief review are timely and proper.

In particular, Applicant requests review of the rejections to claims 22, 24-34, 36-44, 46-49, 52-75, and 78-79 under 35 U.S.C. § 102(e) over U.S. Published Patent Application No. 2004/0044532 to Karstens. Further, Applicant seeks review of the rejection of claims 35, 51, and 77 under 35 U.S.C. § 103(a) over Karstens. Further, Applicant seeks review of the rejection

of claims 23, 50, and 76 under 35 U.S.C. § 103(a) over Karstens in view of IR and RF being utilized to transmit data to devices. Applicants submit that Karstens is not prior art because Applicants invented the claimed invention prior to September 3, 2002, the filing date of the Karstens patent application. On Page 2 of the October 27, 2006 Final Office Action, the 131 Declaration has been deemed ineffective to overcome U.S. Published Patent Application No. 2004/0044532 to Karstens ("Karstens"), the reference cited under § 102(e). Therefore, Applicants request review of the Examiners holding that the facts presented in the Declaration 131 are insufficient to overcome the rejections.

Declaration under 37 CFR § 1.131

On September 11, 2006, Applicants submitted a declaration under 37 C.F.R. § 1.131 ("131 Declaration"). The 131 Declaration provided by Greg B. Hale, Phu Nguyen, and William G. Wiedefeld establishes conception of the invention before the filing date of Karstens and diligence at least up until the constructive reduction to practice of the filing of U.S. Provisional Application Serial Number 60/421,255 on October 25, 2002.

Applicants have previously submitted arguments that the 131 Declaration establishes conception of Claims 22-44, and 46-79. See Applicants' Response of Office Action page 12-13. Furthermore, in the Office Action of October 27, 2006, it is stated that "the earlier draft of 19 April 2002 does not contain the features that make the invention unique." This characterization is misplaced. Phu Nguyen's email of May 30, 2002 refers the Patent Disclosure Fax not being updated, and not any other document. Applicants have not made any admissions about the subject matter of the April 19, 2002 disclosure document.

Applicants have provided evidence to establish diligence from a data prior to the date of reduction to practice of the Karstens reference to either a constructive reduction to practice or an actual reduction to practice. The period for continued diligence is the period between September 3, 2002 and October 24, 2002 for claims 22-44 and 46-79. In the Final Office Action of October 27, 2006 the Examiner has stated that there are a "number of gaps that fail to account or provide a showing for the entire period in which diligence is required." In particular, it is stated that no evidence of diligence has been provided for the following periods: 1) from just prior to

September 3, 2002 to September 18, 2002, 2) from September 20, 2002 to October 13, 2002, and 3) from October 15, 2002 to October 22, 2002.

The Examiner has cited the MPEP stating that a two-day period of inactivity is fatal. “A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue).” MPEP § 2138.06. Applicants submit that In re Mulder does not stand for the proposition that two-days during the diligence period without evidence of diligence, while the rest of the period is full with evidence of diligence, would preclude an applicant from proving diligence. Rather, it says that even when the diligence period is as short as two-days, the applicant must show some evidence. Thus, what made Mulder’s case fatal was that no evidence of diligence whatsoever was provided by Mulder for the entire critical period of diligence. The court indicated that the applicant had to provide *some* proof of diligence during the critical diligence period. “A liberal construction of the rule ... will permit applicants to show diligence from just prior to the date of the reference to their ... filing date ... but liberality cannot be extended to the point of eliminating all proof of diligence, no matter how short the proof to be covered. Appellant’s difficulty, as the have had to admit, is that there is no evidence whatever of record showing diligence, and therefore they cannot comply with the rule.” In re Mulder, 716 F.2d 1542, 1545. Unlike in In re Mulder where no evidence of diligence was offered at all, Applicants have provided numerous documents evidencing diligence towards constructive reduction to practice of the instant application. In addition, Applicants were diligently reducing the invention to practice from just prior to September 3, 2002 to October 24, 2002.

Applicants submit that during the periods, 1) from just prior to September 3, 2002 to September 18, 2002, 2) from September 20, 2002 to October 13, 2002, and 3) from October 15, 2002 to October 22, 2002, Applicants’ representative Margo Maddux was preparing the provisional patent application and therefore diligently working towards reduction to practice. Applicants have submitted various documents evidencing work in progress. As shown in connection with Exhibit C of the 131 Declaration, a status report dated September 19, 2002, demonstrates that Applicants’ representative had been drafting the provisional patent application of the instant application at least during the period of from just prior to September 3, 2002 to September 18, 2002. Furthermore, as show below in connection with Exhibit H of the 131

Declaration, Applicant's representative provided a draft of the provisional patent application on October 22, 2002. This further demonstrates that Applicant's representative had been drafting the provisional patent application of the instant application at least during the periods from September 20, 2002 to October 13, 2002, and from October 15, 2002 to October 22, 2002.

Applicants submit that reasonable attorney diligence was used when preparing the provisional application through the entire critical period. In general, courts have held that a rule of reason should apply in determining attorney diligence. "We agree ... that a rule of reason should be followed in cases of this kind and that courts should be somewhat liberal in determination of diligence of attorneys and of their clerical and stenographic staffs, since the law cannot presume that such people can immediately begin and expeditiously perform their duties as soon as work appears on their desks." D'Amico v. Koike, 347 F.2d 867, 871 (CCPA 1965). Furthermore, a two-month period is reasonable in preparing a draft patent application. Sekine v. Seely, 826 F.2d 1073, (Fed. Cir. 1987)(holding that fifteen weeks is not an excessive amount of time to prepare a patent application for purposes of attorney diligence). A draft was prepared and provided to the inventors at least on October 22, 2002. Therefore, the time needed to prepare the provisional patent application draft required previous work that took place during the period from just prior to September 3, 2002 to October 24, 2002. Accordingly, Applicants submit that Applicant's representative was reasonably diligent in preparing the provisional patent application.

In addition, Applicants have provided documentary evidence in the 131 Declaration that demonstrates the diligent effort to pursue development of the invention during the period of September 3, 2002 and October 24, 2002. In particular, Exhibits C, D, E, F, G, H, and I, referenced in paragraphs 9-14 of the 131 Declaration provide various communications and evidence indicative of work in progress regarding the preparation of a draft of a provisional patent application.

The Office Action of October 27, 2006 states that "is it unclear as to how/why Exhibit C is actually evidence regarding the constructive reduction to practice for the claimed invention" Exhibit C is indicative of work in progress of the preparation of the provisional patent application, which is Applicants constructive reduction to practice. Row 16 of the table of

Exhibit C includes a description of the progress of the preparation of the provisional patent application of the instant application. The first column indicates the attorney docket number 022500 which corresponds to the matter number assigned solely to the preparation of provisional patent application at the firm Greenberg Traurig, LLP. The complete attorney docket number is 54317-022500 and is shown in conjunction with the provisional patent applicant 60/421,255 as show in the USPTO's website Private PAIR. Furthermore, the title of the matter "IR Streaming of Digital Data" is the attorney matter name corresponding to the provisional patent application of the instant application. The third column of row 16 further shows the entry "Missing information, file provisional app, telephone conference schedule with inventor." This entry is not a status report on a patentability search, but rather a report on various tasks been performed in relation to the constructive reduction to practice of the invention. Applicant's representative Margo Maddux was preparing a provisional patent application and that work had been in progress prior to September 19, 2002. Applicants submit that Exhibit C at least partially establishes evidence of diligence towards constructive reduction to practice.

Accordingly, in light of the forgoing remarks it is submitted that Applicant has submitted sufficient evidence to demonstrate diligence during the critical period. Reconsideration of the 131 Declaration and withdrawal of the 35 U.S.C. § 102/103(a) rejections to the claims are, therefore, respectfully requested. No additional fee is believed to be necessary. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2638. Please ensure that the Attorney Docket Number is referenced when charging payments or credits for this case.

Date: March 21, 2007

Respectfully submitted,

Customer Number 46560
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Phone: (310) 586-7700
Fax: (310) 586-7800
E-mail: tapiap@gtlaw.com
LA126725250



Pablo Tapia
Reg. No. 52,275